

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 064706-0016	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>August 1, 2011</u> Signature <u>/Jessica Brown/</u> Typed or printed name <u>Jessica Brown</u>	Application Number  10/054,106		Filed  2001-11-13
	First Named Inventor  CENTER, Steven S.		
	Art Unit  3689	Examiner  Unknown	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest.            See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.            (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record.            Registration number <u>28,590</u>.  <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.            Registration number if acting under 37 CFR 1.34 _____         </div> <div style="width: 45%;"> <u>/Marc E. Brown/</u>  <div style="text-align: right;">Signature</div> <u>Marc E. Brown</u>  <div style="text-align: right;">Typed or printed name</div> <u>(310) 788-1569</u>  <div style="text-align: right;">Telephone number</div> <u>August 1, 2011</u>  <div style="text-align: right;">Date</div> </div> </div>			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

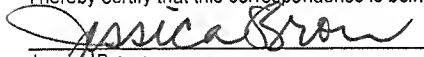
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of	:	Customer Number: 33401
	:	
CENTER, STEVEN S., et al.	:	Confirmation Number: 3632
	:	
Application No.: 10/054,106	:	Group Art Unit: 3689
	:	
Filed: November 13, 2001	:	Examiner: Unknown
	:	
For: ONLINE SYSTEM AND METHOD FOR LOCATING AND REFERRING AN AUTOMOBILE DEALER TO CUSTOMERS		

**CERTIFICATE OF ELECTRONIC TRANSMISSION**

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office On August 1, 2011

  
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Jessica Brown

**REMARKS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

***Prosecution Status***

This is an appeal from the final rejection of claims 1-3, 10-19, and 23-39.<sup>1</sup>

During an interview with assigned Examiner Michael J. Fisher on June 2, 2011, Examiner Fisher surprisingly advised that he had not allowed any patent application this entire year. If applicants wanted to get this application allowed, he said, applicants should file an appeal and request a pre-appeal brief review.

A first response to the final office action was filed later this same day.

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<sup>1</sup> The claims were last set forth in an amendment filed on June 2, 2011. (Only claim 1 was amended to correct an obvious typographical error.)

The USPTO has never responded in any way to this filing, and Examiner Fisher no longer appears to be employed by the USPTO.

***Claim Rejections – 35 USC § 103***

Claims 1-3, 10-17, 20, 23-35, and 38-39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wanker (U.S. Patent 7,302,429) alone.

Claim 1 recites an automated method for referring prospective customers to automobile dealers. In the past, prospective customers were commonly referred to the dealer that was closest to the customer. Admittedly-novel method claim 1 recites a markedly different approach. A database of contact information is searched for: (1) dealers with whom the prospective customer had contact and for: (2) the reason for each contact. Two dealers are located. The first is a dealer that had contact with the customer for the reason of servicing a vehicle. The second is a dealer that had contact with the customer for the reason of purchasing a vehicle. Even though the second dealer is further from the customer than the first, the customer is provided a referral that gives preference to the second dealer.

Wanker ranks merchants based on weighting information. Col. 2, lines 33-38. The weighting information can include “merchant service ratings 281,” “merchant response rating 282,” history of customer complaints 283,” evaluation of handling of complaints 284,” and “boycott information.” FIG. 2G.<sup>2</sup> However, and as correctly recognized in the office action, Wanker does not teach “using the current user’s prior contacts,” nor even “receiving the identify of each prospective customer.” Office Action at p. 3. The office action nevertheless contends that it would have been obvious to have modified Wanker to have performed these missing steps.

One serious problem with this position is that this modified version of Wanker still fails to perform significant steps of claim 1. For example, it still fails to provide a referral that gives preference to a dealer that had a purchasing contact with the prospective

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<sup>2</sup> The office action also cites prior purchaser and consumer feedback information (item 274 in FIG. 2F). However, it is clear from the caption of FIG. 2F (“Product Information from Third Parties”) that this information is about products, not merchants.

customer over a closer dealer that had a servicing contact, as required by claim 1. The office action fails to offer any reason as to why this substantial difference between this modified version of Wanker and claim 1 was obvious. Thus, a *prima facie* showing of obviousness in connection with claim 1 has plainly not been set forth. See MPEP 2142 ("The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. . . . The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . '[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'").

The sole reason offered by the examiner for modifying Wanker to use prior contacts of a prospective customer when making a referral is also deficient on its face. The examiner states on page 3 that it was obvious to have made this modification because "the system [in Wanker] is shown to do this in the aggregate and the current customer would be one of the 'prior contacts' as disclosed." However, there is absolutely nothing in Wanker which discloses or suggests that the data on which a referral is based includes a prior contact of the prospective customer. To the contrary, Wanker does not even keep track of who had the prior contacts, making such step impossible.

In short, other than ranking merchants, Wanker has little to do with the process recited in claim 1. The examiner's contrary conclusion of obviousness fails to offer any reason as to why a significant differences between a modified concoction of Wanker and claim 1 was obvious. The reason offered for one of these modifications is also deficient on its face.

Independent claim 20 is a systems counterpart to independent claim 1 and is patentable in view of Wanker for comparable reasons.

Independent claim 23 is also similar to claim 1, but provides information about a dealer that had a prior contact with the prospective customer when there was such a contact, but about the closest dealer when there was no prior contact. Again, nothing in

the examiner's modified version of Wanker performs this step, nor has the examiner otherwise offered any reason as to why this significant difference was obvious. Again, therefore, a *prima facie* showing of obviousness has not been presented. See "MPEP 2142 (quoted above).

Independent claim 38 also has similarities to claim 1, but more generally gives preference to dealers who had a prior contact for one reason as compared to a prior contact for another reason. Again, nothing in the examiner's modified version of Wanker performs this step, nor has the examiner otherwise offered any reason as to why this significant difference was obvious. Again, therefore, a *prima facie* showing of obviousness has not been presented. See "MPEP 2142 (quoted above).

Independent claim 39 is similar to independent claim 1, but gives preference to a seller who had a prior contact with the prospective customer as compared to a seller that did not. Again, nothing in the examiner's modified version of Wanker performs this step, nor has the examiner otherwise offered any reason as to why this significant difference was obvious. Again, therefore, a *prima facie* showing of obviousness has not been presented. See "MPEP 2142 (quoted above).

The remaining claims are dependent upon one of these independent claims and thus are patentable for the same reasons given above.

Claims 18-19 and 36-37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wanker as applied to claims 1-3, 10-16, 23-35, and 38-39 in view of Chislenko (U.S. Patent 6,041,311). Claims 18-19 are dependent upon claim 1 and claims 36-37 are dependent upon claim 23. As explained above, claims 1 and 23 are patentable in view of Wanker because of deficiencies in this reference. Chislenko does not make up for any of these deficiencies.

### CONCLUSION

For the foregoing reasons, it is respectfully submitted that this application is now in condition for allowance and early notice of the same is earnestly requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper or any other paper or matter in this application, including extension of time fees, to Deposit Account 501946, and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Marc E. Brown, Registration No. 28,590

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**Date: August 1, 2011**